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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/295,856 04/21/99 COLLART

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EXAMINER

RODRIGUEZ, P

ART UNIT

PAPER NUMBER

2121

DATE MAILED:

12/11/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/295,856

Applicant(s)

COLLART, TODD R.

Examiner

Paul L Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-17, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 13, 14 and 18 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 29 September 2000 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 8 9 10.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### **DETAILED ACTION**

1. The amendment filed 29 September 2000 has been received and considered.

#### ***Specification***

2. Applicant should be advised that the amendment to page 11 lines 14-17 probably should have been to lines 14-27. As currently written, the paragraph starting with "Finally, ..." is listed in the specification twice.

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (see amendment for page 34 lines 22 through 29, adds additional hypertext). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

#### ***Claim Objections***

4. Claim 20 is objected to because of the following informalities: Claim 20 is dependent from claim 1, claim 20 refers to "The system of Claim 1", Claim 1 is a method claim. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10, 12 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claims 1 and 6 recites the limitation "the tracking information" in claim 1 line 9 and claim 6 lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

8. Claims 2, 7 and 12 recites the limitation "the retailer" in claim 2 line 2, claim 7 line 2 and claim 12 line 3. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 7 recites the limitation "the package" in claim 7 line 3. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 20 recites the limitation "the system" in claim 20 line 1. There is insufficient antecedent basis for this limitation in the claim.
11. Claim 20 recites the limitation "said database" in claim 20 line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 4, 6, 7, 9, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (U.S. Pat. 5,860,068) in view of Fuchigami et al (U.S. Pat. 5,960,398).

Cook provides a method and system/apparatus for selling, distributing and tracking digital data products from retail stores over the Internet, telephone lines and other electronic means. The Cook reference teaches a method for tracking the distribution of content electronically (Col. 10 lines 49-55). Cook teaches incorporation of a tracking identifier on the package containing the electronic medium (Col. 10 lines 23-38). Cook teaches storing the tracking identifiers in a database, and detecting the tracking information when the electronic storage medium is coupled with a computer (Col. 10 lines 38-41). Cook teaches transmitting the

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tracking information to a server computer (Col. 10 lines 45-55). Cook teaches logic in a server computer that determines as a function of the tracking information, appropriate updated information utilizing logic in the server computer to transmit to the computer (Col. 10 lines 48-55). Cook teaches a server computer performing a lookup to determine the retailer (Col. 6 lines 25-44). Cook teaches a server computer transmitting an information banner to the computer (Col. 6 lines 51-60). Cook teaches a system comprising a means for accessing a database in response to reading the identifier from the optical storage medium (Col. 6 lines 24-44), means for selecting content as a function of data accessed from the database in response to the reading of the identifier from the optical storage medium (Col. 6 lines 34-44), means for retrieving content, the means for retrieving content being responsive to the means for selecting content (Col. 6 lines 45-67) and a computer network interposed between the means for reading the optical storage medium and the database (Col. 6 lines 25-34 and Col. 7 lines 13-19)

Cook fails to teach the incorporation of an electronic storage medium tracking identifier on the electronic storage medium, an optical disc having a burst cut area, a digital code stored in the burst cut area, a digital code representative of an identifier of content on the optical disc storage medium and a means for reading an optical storage medium, including means for reading an identifier from the optical storage medium.

Fuchigami et al teaches incorporation of an electronic storage medium tracking identifier on the electronic storage medium (Col. 5 lines 45-56). Fuchigami et al teaches, an optical disc having a burst cut area, a digital code stored in the burst cut area, and a digital code representative of an identifier of content on the optical disc storage medium (Col. 5 lines 45-65). Fuchigami et al teaches a means for reading an optical storage medium, including means for reading an identifier from the optical storage medium (col. 11 lines 64-66).

Cook and Fuchigami et al are analogous art because they both are related to the reproduction and distribution of electronic medium.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the copyright information embedding apparatus of Fuchigami et al into the method and system for selling and distributing digital data products from retail stores over the Internet, telephone lines and other electronic means of Cook because Fuchigami et al provides a system that provides copyright protection of data on optical disc without the degradation of the information contained on the disk and unauthorized copies of the data can be easily identified. Also, the digital data embedded in the burst cut area on the disc can have many different identifiers, such as a cutting player identification code, a source identification code, a recording date, a number of recordings, number of copies, or any other information desired.

14. Claims 5, 10-12, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (U.S. Pat. 5,860,068) in view of Fuchigami et al (U.S. Pat. 5,960,398) as applied to claims 1, 2, 4, 6, 7, 9, 19 and 20 above, and further in view of Ginter et al (U.S. Pat. 5,892,900).

Cook as modified by Fuchigami et al teaches a method and system for selling and distributing digital data products in an optical disc format, where information about the optical disc is embedded on the disc using a burst cut area, and shipping information is tracked over the Internet as recited in claims 1, 2, 4, 6, 7, 9, 19 and 20 for the reasons above, differing from the invention as recited in claims 5, 10-12, and 15-17 in that their combined teaching lacks transaction data written to a database memorializing processing, a program embodied on a computer readable medium for identifying and providing a response to the use of an electronic storage medium having a tracking identifier incorporated thereon, a code segment that reads the

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identifier of the electronic storage medium upon being input into a computer by a user and the code segment that receives live update information from the server computer.

Ginter et al teaches a system and method for secure transaction management and electronic rights protection. Ginter et al teaches transaction data written to a database memorializing processing (Col. 24 lines 24-53). Ginter et al teaches a program embodied on a computer readable medium for identifying and providing a response to the use of an electronic storage medium having a tracking identifier incorporated thereon (Col. 235 line 28 – Col. 237 line 54). Ginter et al teaches the server computer receiving live update information from the server computer (Col. 90 lines 42-50). Because Ginter et al teaches a system and method that utilizes computer system to perform the steps above, it would be obvious to provide computer programs and code to perform the above steps.

Cook as modified by Fuchigami et al and Ginter et al are analogous art because they both provide a means to track distributions of sold items electronically utilizing computer networks.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a system and method for secure transaction management and electronic rights protection of Ginter et al in the method and system for selling and distributing digital data products of Cook as modified by Fuchigami et al to include a distributed system software for users of the e-commerce systems because the Virtual Distribution Environment of Ginter et al provides protection of electronic rights for authors of electronic content, commercial rights, rights of parties who facilitated the distribution of content and privacy rights for parties portrayed by distributed content (Col. 5 lines 29-39).

***Allowable Subject Matter***

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15. The following is a statement of reasons for the indication of allowable subject matter:  
While MASCHA M et al (provided in the IDS submitted 11/14/00) teaches a server computer performing a table lookup to determine an authorized title (page 270, column 2 paragraph 3) in and of its self there is insufficient motivation to combine the MASCHA M et al teaching with the electronic medium tracking system of Cook as modified by Fuchigami et al and Ginter et al, absent impermissible hindsight reconstruction using applicants disclosure.

16. Claims 3 and 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

17. Claims 13, 14 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

18. Applicant's arguments filed 29 September 2000 have been fully considered but they are not persuasive.

Regarding references listed in the specification, which should have been listed on an IDS, they have now been considered using the IDSs submitted.

Regarding the drawing objections, the changes are approved and the objections are withdrawn.

Regarding the objections to the specification, amendment entered, objections withdrawn.

Regarding the U.S.C 35 USC § 112 2<sup>nd</sup> rejections, the claims that were rejected due to the limitation "the tracking information" are maintained. Examiner does not consider the "tracking



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identifier” and the “tracking information” to be the same. The rejection of claim 11 due to “the package” is withdrawn. Additional 112 2<sup>nd</sup> rejections are made above.

Regarding the rejection of claims 1, 2, 4, 6, 7 and 9, specifically that Cook does not teach or suggest “logic... that determines, as a function of the tracking information, appropriate updated information to transmit to the computer”. Examiner feels that Cook does support this limitation, Cook teaches “the bar code is read” (col. 10 lines 38-39), “the information is sent to the shipping management subsystem” (col. 10 lines 39-40), then the “shipping management subsystem also preferably generates a second e-mail message or otherwise provides information to the customer” (col. 10 lines 45-47). Cook provides a selling and tracking system used in the distribution of electronic medium. Cook also teaches a means for communicating data that is read from an electronic medium (bar code), which is sent to a server computer for processing the data, information is sent from a server computer to a customer, the customer is provided with an updated information as to the status of the electronic medium in the form of a status e-mail. Fuchigami et al provides the specific teaching of using a burst cut area on an electronic storage medium so that a specific data can be stored and later read, the burst cut area is used similarly as the bar code used by Cook, the data storage simply takes a different form. Regarding the argument that the data content for Fuchigami et al is different and that it is not tracking information (col. 11 line 64- col. 12 line 21 describes the data stored in the BCA), the specification on page 12 refers to the tracking information as containing the DVD title along with other data. Therefore the copyright data of Fuchigami et al can also be considered as containing tracking information as defined in the specification. The rejections of these claims are maintained.

Regarding the rejection of claims 3 and 8, the rejection is withdrawn, argument persuasive.

Regarding the rejection of 5, 10-12 and 14-17. The memorializing is taught by Ginter et al, were the recording of database transactions is supported, the feature of memorializing is known in the art of computer databases. Providing a computer program or specific code to perform tasks or methods is not novel, Cook, Fuchigami et al and Ginter et al are all computer based systems, it would be obvious to provide computer programs and specific code to carry out their functions even though it is not specifically recited in the specifications of those documents. Regarding the rejection of claim 14, this rejection is withdrawn because the arguments for the Coddington et al reference was persuasive and the limitation of "authorized playback of authorized information" is similar to the argument that performing a table lookup to determine one or more authorized titles was not properly supported. Therefore, the rejection of claims 5, 10-12 and 15-17 are maintained and the rejection of claim 14 is withdrawn.

Regarding the rejection of claim 13, the rejection is withdrawn, argument persuasive.

Regarding newly added claims 19 and 20, these claims are rejected, see above rejections.

### ***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Moore (U.S. Pat 5,895,073) – provides a tracking method for the sale of goods. Ozaki et al (U.S. Pat 5,991,798 – provides server connection in conjunction with a CD-ROM medium to provide additional data for display and operation with data on the CD-ROM.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399. The examiner can normally be reached on 6:30 - 4:00 M-Th and alternate F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Grant can be reached on (703) 308-1108. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3718 for regular communications and (703) 305-3718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Paul L Rodriguez  
Examiner  
Art Unit 2121

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December 7, 2000

  
WILLIAM GRANT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

12/7/00